

## REMARKS

This Amendment and Response is submitted in response to the Office Action mailed 24 SEPTEMBER 2003. Withdrawal of the rejection and reconsideration with an eye toward allowance is respectfully requested.

### Claim Status

Claims 1-29 are pending after entry of the present amendment. Claims 1-8 stand rejected. Claims 9-29 are added herein. A complete listing of all claims that are, or were in the application, along with an appropriate status identifier, is provided above in the section entitled "Amendments to the Claims". Markings are provided on claims amended in the present amendment.

Support for the above claim amendments can be found throughout the originally filed specification, drawings, and claims. For example, support for new claims 9-29 can be found at least on pages 8-10.

### Claim Rejections – 35 U.S.C. §103

Claims 1-8 were rejected under 35 U.S.C. §103(a) as being unpatentable over Deaton et. al. (Patent Number 5,642,485) in view of Kepecs (Patent Number 6,009,411) and Burton (Patent Number 5,025,372).

Deaton is directed toward a method and system for customer promotion (see abstract). Deaton discloses a method for retail store marketing which begins with the stored database of existing customers of the retail store. A list of prospective customers living in a geographical area is obtained and stored. Comparison is made of the stored database with the list of prospective customers, and all data is eliminated from the list of prospective customers which relates to information contained in the stored database, such that a non-customer database is produced which contains data relating only to prospective customers who do not appear on the stored database. (see col. 62, line 43 – col. 63, line 8).

Kepecs is directed toward a system and method for distributing promotions (see abstract). A consumer browses through discounts or other promotions available to him or her at a DAP Internet server and selects the desired discounts. The purchase of discounted products by the consumer is later validated through an exchange of information between the store computer and the DAP server. (see col. 9, lines 20-61).

Burton is directed to a system and method for administration of an incentive award program (see abstract). Monetary amounts are awarded to participants for expenditure through the participants' credit instrument accounts depending on the participant's achieving a certain level of performance.

Applicants note that to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference teachings. (See M.P.E.P. §2142).

Applicant respectfully submits that the Examiner has not provided a proper motivation to combine the reference teachings. The Examiner suggests that the motivation to combine the teaching of Deaton with that of Kepecs would be to provide a customer with discount choices of items available in a collection of stores over a network (see office action, page 4). The Examiner points to Kepecs at col. 2, lines 40-48 to provide this motivation. Applicant respectfully submits that Kepecs, at col. 2, lines 40-48, discloses presenting discount choices to consumers over a network. Applicant respectfully submits that Kepecs does not provide a motivation to combine their solution with Deaton's method and system for producing a non-customer database which contains data relating only to prospective customers who do not appear on a stored customer database. Applicant respectfully notes that "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fritch, 23 USPQ2d 1780, 1784 (CAFC 1992). Applicant respectfully submits that there would be no motivation to combine Deaton's methods to generate a list of non-customers, with Kepecs' methods to allow loyal customers to browse awards on a server, as Kepecs' methods are directed toward rewarding customers while Deaton's are directed toward identifying non-customers. Accordingly, Applicant submits that the 35 U.S.C. §103 rejection is improper.

As to the further combination of Deaton and Kepecs with Burton, the Examiner suggests that the motivation would be to offer participants of the incentive program an unlimited degree of flexibility for selection of their own personal award, thereby providing motivation for participants to use the incentive program (see office action, page 5). The Examiner points to Burton at col. 4, line 63 – col. 5, line 4, where Burton discloses that providing an incentive program awarding monetary amounts to participants' credit instrument accounts has the advantage of providing flexibility to participants for selection of their own award (see col. 4, lines 9-19 and col. 4, lines 63-69). Applicant respectfully submits that Burton does not provide a motivation for combining this monetary reward system with either the method for generating a list of non-customers disclosed by Deaton or the system allowing loyal customers to browse rewards on a network disclosed by Kepecs. There would be no motivation to combine Deaton's disclosure with that of Burton, as Deaton is directed toward generating a list of non-customers while Burton is directed to rewarding participants achieving a certain performance level. Further, there would be no motivation to combine Kepecs' disclosure with that of Burton, as Kepecs is directed toward allowing customers to browse through awards offered on a network while Burton has emphasized the advantage of simply providing customers with monetary rewards directly on their credit instruments. Accordingly, Applicant submits that the 35 U.S.C. §103 rejection is improper, as proper motivation to combine the three cited references is lacking.

For at least these reasons, Applicant submits that the 35 U.S.C. §103(a) rejection of claims 1-8 is improper, and should be withdrawn.

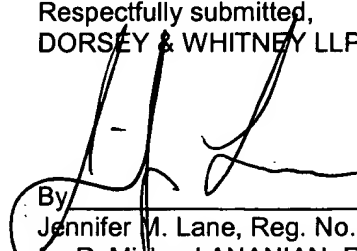
### New Claims

Applicant has added new claims 9-29 which further distinguish over the cited art. For example, claims 9-10 recite discount offers, claims 11-12 recite methods of payment, claim 13 recites presenting an offer at a first merchant, claims 14-16 recite an offer, claims 17-18 recite methods of payment, and claims 19-21 recite point of sale platforms. Claims 22-28 recite a computer program product, and claim 29 recites a system. The cited art fails to disclose or suggest these features. Other of the added claims present other features that are neither disclosed nor suggested by the cited art.

### CONCLUSION

Applicants submit the claims are in condition for allowance, and notification of such is respectfully requested. If after review, the Examiner feels there are further unresolved issues, the Examiner is invited to call the undersigned at (415) 781-1989.

Respectfully submitted,  
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